



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/826,577	04/02/97	DIXIT	V 203442102501 <sup>mk</sup>

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HM12/0316

EXAMINER

HAYES, R

ART UNIT

PAPER NUMBER

1645

21

DATE MAILED: 03/16/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/826577

Applicant(s)

Dix +

Examiner

Hayes

Group Art Unit

1645

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 1/4/99.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 42, 45, 48-49, 56-57 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 42, 45, 48, 56 is/are allowed.
- ☒ Claim(s) 49, 57 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

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**DETAILED ACTION**

1. The amendment filed 01/04/99 has been entered.
2. The rejection of claims 1 & 36-41 under 35 U.S.C. 112, first paragraph, as containing new matter is withdrawn due to the cancellation of these claims.
3. The rejection of claims 1, 22-23, 36-41, 43-44 & 54-55 under 35 U.S.C. § 112, first paragraph, is withdrawn due to the cancellation of these claims.
4. The rejection of claims 1, 22-23, 36-41 & 54 under 35 U.S.C. 112, second paragraph, as being indefinite for reciting negative claim language is withdrawn due to the cancellation of these claims.
5. The rejection of claims 43-44 under 35 U.S.C. 112, second paragraph, as being indefinite is withdrawn due to the cancellation of these claims.
6. The rejection of claims 22-23, 37 & 40-41 under 35 U.S.C. 102(a) as being anticipated by Rothe et al. is withdrawn due to the cancellation of these claims.
7. Claims 42, 45, 48 & 56 are allowed.

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8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
9. Applicants' arguments filed 01/04/99 have been considered but are not found persuasive.
10. Claim 49 and new claim 57 are again rejected under 35 U.S.C. 112, second paragraph, as being indefinite and incomplete because it is unknown what is envisioned as the intended use of the pharmaceutical compositions, since none is recited.

Applicant argues on page 2 of the response that "page 9, line 19 to page 10, line 23 and pages 28-29"... "set forth the utility for the [claimed] pharmaceutical composition[s]". In contrast to Applicants' assertions, the issue remains that these claims are "incomplete" in that no known use is disclosed within the specification, because no CD40-related diseases are known, or disclosed. For example, use as a reagent on a column, use as an immunogen or as a screening agent are not pharmaceutical uses. It is noted that no 35 USC 101 rejections have been made of record, as it relates to "utility".

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (703) 305-3132. The examiner can normally be reached on Monday through Thursday, and alternate Fridays, from 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Robert C. Hayes, Ph.D.  
March 15, 1999



ANTHONY C. CAPUTA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600